REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3-19 and 24 are pending in the present application, with Claims 1 and 3 amended, Claims 2 and 20-23 cancelled, and Claim 24 added by the present amendment.

In the outstanding Office Action, Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones (U.S. Patent No. 6,606,506 B1) in view of the Operating Instructions for the Sony CDP-X77ES Compact Disc Player (hereinafter CDP-X77ES); Claims 1, 4-6, 11, 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush (U.S. Patent No. 6,466,677 B1) in view of Vogel (GB 2326788 A) and further in view of CDP-X77ES; Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush, in view of Vogel, CDP-X77ES and further in view of an examiner's official notice; Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush, in view of Vogel, and CDP-X77ES and further in view of Anderson (U.S. Patent No. 5,316,249 A); Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush, in view of Vogel, CDP-X77ES, and further in view of Foster (U.S. Patent No. 5,587,704 A); Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush, in view of Vogel, CDP-X77ES and further in view of Huang et al. (U.S. Patent No. 6,437,836 A, hereinafter Huang); Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush, in view of Vogel, CDP-X77ES and further in view of an examiner's official notice; Claims 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush, in view of Vogel, and CDP-X77ES and further in view of Kitao et al. (U.S. Patent No. 6,124,804 A, hereinafter Kitao); Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush, Vogel, CDP-X77ES, Kitao, and further in view of an examiner's official notice,

with evidence provided by Holling et al. (U.S. Patent No. 6,378,874 A, hereinafter Holling); and Claims 3, 10 and 14 were indicated as containing allowable subject matter.

Applicants acknowledge with appreciation the indication of allowable subject matter.

Claim 1 is amended to include the features of cancelled Claim 2. Claim 3 is amended to depend from Claim 1. Support for new dependent Claim 24 is found in Applicants' original specification.[1] No new matter is added.

In view of the amendment to Claim 1, the only outstanding rejection is the rejection of now cancelled Claim 2 under 35 U.S.C. § 103(a) in view of Bush, Vogel, CDP-X77ES and an examiner's official notice.

Briefly recapitulating, amended Claim 1 is directed to an audio system, comprising a head attachment audio unit having a reproduction portion configured to reproduce audio information stored in a memory portion and an output portion configured to output sound according to the reproduced audio information. The audio system also includes a remote control unit having a plurality of operation buttons, each operation button configured to implement a corresponding one of a plurality of operation modes for audio reproduction. The plurality of operation modes include a) a start reproducing audio information mode, b) a stop reproducing audio information mode, c) a reversing mode, and d) a fast forwarding mode. The remote control unit is configured to transmit a control signal that controls the plurality of operation modes for audio reproduction of the reproduction portion. The remote control unit is configured to transmit the control signal via radio. According to the present invention, each operation mode can be controlled through separated operation buttons. Since the operation buttons have unique functions, the user can select an operation mode visually and easily.

[1] Specification, page 6, lines 21-23; page 15, lines 2-15

Bush discloses a cordless audio headphone having a memory card.[2] However, Bush does not disclose or suggest a remote control device of any sort, let alone Applicants' claimed remote control device.

Vogel discloses a personal radio system comprising a radio receiver headset 10 and a remote control unit 12, where control of all functions are provided by different combinations of a minimum number of keys on the remote control unit, preferably no more than two.[3]

First and foremost, Applicants submit there is no teaching, suggestion, or motivation, either explicitly or implicitly, in either reference to combine the device of Bush with the remote control of Vogel to arrive at Applicants' invention recited in amended Claim 1. Bush is explicitly without a remote control. Thus, Applicants submit it is only through an impermissible hindsight reconstruction of Applicants' invention that the rejection of previously pending Claim 1 or Claim 2 can be understood.[4]

Furthermore, the remote control unit of Vogel permits functional operation based solely on the use of two manually operated keys.[5] That is, Vogel does not teach "a remote control unit having a plurality of operation buttons, each operation button configured to implement a corresponding one of a plurality of operation modes for audio reproduction, the plurality of operation modes comprising a start reproducing audio information mode, a stop reproducing audio information mode, a reversing mode and a fast forwarding mode" as recited in amended Claim 1. According to the present invention, each operation mode can be controlled through separated operation buttons. Since the operation buttons have unique functions, the user can select an operation mode visually and easily. However, in Vogel the

[2] Bush, abstract.
[3] Vogel, page 6, line 20.
[4] MPEP § 2143.01 "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge of one of ordinary skill in the art."
[5] Vogel, page 8, line 31.

user can not select the operation mode visually with the remote control unit because one key/switch of Vogel must be combined with the other key/switch.

Furthermore, Applicants submit that Vogel teaches away from Applicants' claimed invention because Vogel aims to reduce the number of buttons on the remote by use of combinations, whereas Applicants' invention purposely claims each operation button corresponds to one of a plurality of operation modes. That is, Vogel specifically prohibits the use of a single button for a single function, as recited in Claim 1.

The Operating Instructions for the Sony CDP-X77ES Compact Disc Player (CDP-X77ES) disclose a remote control having a plurality of operation buttons. Although the CDP-X77ES discloses a remote control having a plurality of operation buttons, the concept of the remote control of the CDP-X77ES is different from that of the present invention because the CDP-X77ES does not teach the idea of enabling the user to select the operation mode visually but teaches merely remote control itself. The concept of the remote control of CDP-X77ES is quite different from that of Vogel as well. Thus, Applicants submit that Vogel and CDP-X77ES are non-analogous because both are based on quite different concepts.

Furthermore, even if the person skilled in the art refers to Bush, Vogel and CDP-X77ES simultaneously, Applicants submit there is no motivation in any of the references to combine the previously cited references with the CDP-X77ES. Bush, Vogel and CDP-X77ES disclose different concepts respectively and do not show any suggestion to combine with other concepts.

Applicants submit the outstanding rejection does little more than attempt to show that parts of the inventive combination of Claim 1 were individually known in other arts and to suggest that such a showing is all that is necessary to establish a valid case of *prima facie* obviousness. The PTO reviewing court recently reviewed such a rationale and dismissed it in *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) as follows:

> As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. [emphasis added.]

There has been no such showing of those required reasons made in the rejection.

Finally, as noted in the Official Action, none of the cited references disclose or suggest any radio based remote control, let alone Applicants' claimed radio control. The Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art.[6] However, as set forth in M.P.E.P. § 2144.03, if an applicant traverses an assertion made by an Examiner while taking official notice, the Examiner should cite a reference in support of their assertion. Applicants respectfully traverse the outstanding grounds for rejection relying on Official Notice. Applicants do not consider the features for which Official Notice were taken to be "of such notorious character that official notice can be taken."

The present amendment is submitted in accordance with 37 C.F.R. § 1.116 which permits amendments placing the claims in better form for consideration on appeal after final rejection. Since the present amendment merely incorporates Claim 2 into Claim 1 and adds a

[6] *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970).

new dependent claim, Applicants submit no new issue is raised. Thus, Applicants request the present amendment be entered.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Eckhard H. Kuesters
Registration No. 28,870
Attorney of Record
Michael E. Monaco
Registration No. 52,041

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
EHK/MEM/agm

I:\ATTY\MM\AMENDMENT\192523\192523.AM DUE 5-24-05.DOC